

REMARKS

Status of the Claims

Claims 1-14, 20, 21, 31, and 32 are pending in the application. Claims 1-14, 20, 21, 31, and 32 stand rejected.

The Office Action

Obviousness-type Double Patenting

The Examiner has provisionally rejected claims 1-14, 20, 21, 31, and 32 as being unpatentable in view of co-pending Application No., 10/166,437. The Examiner contends that “although the conflicting claims are not identical, they are not patentably distinct from each other because overlapping claimed subject matter is involved.” The Examiner further contends “the species in 10/166,437 anticipate the present claims.” Applicants traverse.

Applicants disagree with the Examiner’s assertions and would like to clarify the record. Nevertheless, solely to expedite prosecution, applicants are filing a terminal disclaimer.

Applicants respectfully submit that the species in 10/166,437 do not anticipate the present claims. As previously discussed in applicants’ response dated June 27, 2005, “applicants recite a proviso that expressly excludes the species of the ‘216 application.” (The ‘216 application is the counter part PCT publication to U.S. application 10/166,437). Specifically, applicants' proviso recites "provided that when Y is halo, then both, R^3 and R^4 , are not simultaneously hydrogen." Claims 2-14, 20-21 and 32 depend either directly or indirectly from claims 1 and 31 and therefore they, too, incorporate this limitation. Accordingly, the species in 10/166,437 do not anticipate the pending claims. Nevertheless, solely to expedite prosecution, applicants have provided a terminal disclaimer.

The Examiner has provisionally rejected claims 1-14, 20, 21, 31, and 32 as being unpatentable in view of co-pending Application No., 10/743,563. The Examiner contends that “although the conflicting claims are not identical, they are not patentably distinct from each other because overlapping the claimed subject matter is involved.”

The Examiner further contends “the species in 110/743,563 anticipate the present claims.” Applicants traverse.

Applicants respectfully submit that the species in 10/743,563 do not anticipate the present claims. The species in 10/743,563 are esters and amides (wherein X is OR¹ or N(R⁵)₂), whereas the instant claims are directed towards carboxylic acids (wherein X is OH).

The instant application was filed on June 27, 2003, which is earlier than the December 23, 2003 filing date for 10/743,563. Accordingly, applicants respectfully request that the Examiner allow the instant claims to issue. Applicants stand ready to consider terminal disclaimers in 10/743,563, the later filed application, once the instant application has issued.

CONCLUSION

Applicants respectfully request that the Examiner consider the foregoing remarks and allow the pending claims to issue. If the Examiner believes that a telephone discussion would further issuance of this application, the Examiner is invited to call the undersigned attorney at any time.

Respectfully submitted,

/Jennifer G. Che/

Jennifer G. Che, Reg. No. 58,035
Attorney for Applicants
Vertex Pharmaceuticals Incorporated
130 Waverly Street
Cambridge, Massachusetts 02139
Tel: (617) 444-6525
Fax: (617) 444-6483